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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,231	12/05/2003	Roger Thomas	P-US-PR 1107	9218

7590

07/13/2005

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EXAMINER

SELF, SHELLEY M

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,231	THOMAS, ROGER	
	Examiner	Art Unit	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/28/04; 12/5/03</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “52” has been used to designate both *expulsion aperture* (pg. 5, lines 4, 6, 27) and *internal wall* (pg. 5, line 26).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 80.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *hoop* (clm. 3), *two pegs* (clm. 12) and *transparent window* (clm. 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/729204. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely re-worded. For example, the claims of the presently presented application are drawn to a debris collection container for a planer comprising a receptacle having a first and second rigid section and deformable section there between and a connector. The claims of the co-pending application are also drawn to a debris collection container comprising a receptacle (clm. 1) having a first and second rigid section and deformable section (clm. 13, 14) there between and a connector. Accordingly, the claims as presented fail to set forth any distinguishing structure over that of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

The disclosure is objected to because of the following informalities:

-Page 4, line 15, "sidewaysly" is unclear

-Page 4, line 27, "rib is angled 35 in", is unclear, Examiner suggests, **--rib is angled 35 degrees in--**

-Claim 3, "fist" should be **--first--**

-Claim 12, line 2, following the word, connection, "mean" should be **--means--**

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claims 1 and 17, neither the specification nor the drawings provide support for first and second rigid section and a deformable section manipulatable between a compressed condition and an expanded condition. With reference to the embodiments of figures 6-8 and 9-12 an end piece (82), a bag (86, 116), frame (114), annular ring (72) and spring (84) are depicted. Failure to correlate or

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provide sufficient antecedent basis for the use of the terms; “first rigid section,” “second rigid section” and “deformable section” renders a clear understanding difficult. It is unclear what structure the first and second rigid sections correlate to with regard to the specification as such terms are not clearly defined within the specification. Further, neither the specification nor the drawings provide support for, “...the first rigid section can be releasably attached to the second rigid section when the deformable section is in a compressed condition.”

Furthermore, the following terms have not been adequately defined within the specification or the drawings to provide sufficient antecedent basis for the terms within the claims:

-connection means (clm. 12)

-transparent window (clm. 14)

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to the failure of the specification to adequately provide sufficient antecedent basis for the terms, first and second rigid sections and deformable section, the claims are particularly confusing. For example, claim 1 clearly states the receptacle to include, “...*a first rigid section, a second rigid section and a deformable section...*”; claim 7 then states a cap to be “*releasably attachable to the receptacle*”; claim 9 then states, “*the first rigid section includes a*

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rim... "; however the specification and the drawings depict the rim to be illustrated as reference character 66 and to be a portion of the cap 60, not the receptacle (fig. 7), thus neither the drawings nor the specification provide support for the claimed invention. Clarification is required.

With regard to claim 3, neither the specification nor the drawings provide sufficient antecedent basis for the term, "hoop", it is unclear what "hoop" refers to. Clarification is required.

With regard to claim 11, it is not clear what is meant by a "*bayonet type*" connector, clarification is required.

Regarding claim 12, the word "means" is preceded by the word(s) "connection" and "biasing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Examiner suggests, --means for connection—and --means for biasing--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-16 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Schneider (6,520,365). With regard to claims 1, 2, 4-6, 8, 10 and 14, Wang discloses a debris collection container for a planer (fig. 2) which employs a stream of air to remove debris generated by the planer (4), the debris collection container comprising: a receptacle for storage of the debris (5); and a connector (fig. 4) connectable between the receptacle (5) having a first rigid section (50) and the planer (fig. 2) defining a path for debris passing from the planer to the receptacle. Wang does not disclose the receptacle having a second rigid section with a deformable section located between and connecting the first rigid section and the second rigid section, or the first rigid section can be releasably attached to the second rigid section when the deformable section is in a compressed condition. Schneider teaches a specific type of receptacle for storage of debris. Schneider teaches a receptacle (fig. 1) having a first rigid section (14), a second rigid section (16, 28) and a deformable section (12, 18) of transparent material located between and connecting the first rigid section and the second rigid section (figs. 1, 2), the deformable section (12, 18) includes a helical spring (20) and is manipulatable between a compressed condition and an expended condition (figs. 1, 2); wherein the first rigid section (14) defines an aperture and can be releasably attached to the second rigid section (16, 28) when the deformable section is in a compressed condition (fig. 2) and wherein the first rigid section is adjacent to the second rigid section. Schneider teaches this construction of a storage/debris receptacle so as to allow efficient storage of the receptacle when not in use. Because both Wang and Schneider teach debris/storage receptacles, it would have been obvious at the time of the invention to replace Wang's receptacle (5) with a

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collapsible receptacle (i.e. first and second rigid sections) so as to facilitate compact and efficient storage of the receptacle when not in use as taught by Schneider.

As to the “hoop”, (clm. 3) as best as can be understood, Schneider discloses a hoop/loop and catch (64, 66) included on the first and second sections (14, 16) for releasably attaching the first section (14) to the second section (16, 28).

With regard to claim 7 as best as can be understood, Wang discloses a cap (fig. 4), releasably attached to the receptacle (5) for sealing the aperture (fig. 1, 2, 4).

With regard to claim 9 as best as can be understood, Wang discloses a first rigid section (50) including a rim (col. 2, lines 19-21) and the cap (fig. 4) releasably attached to the rim.

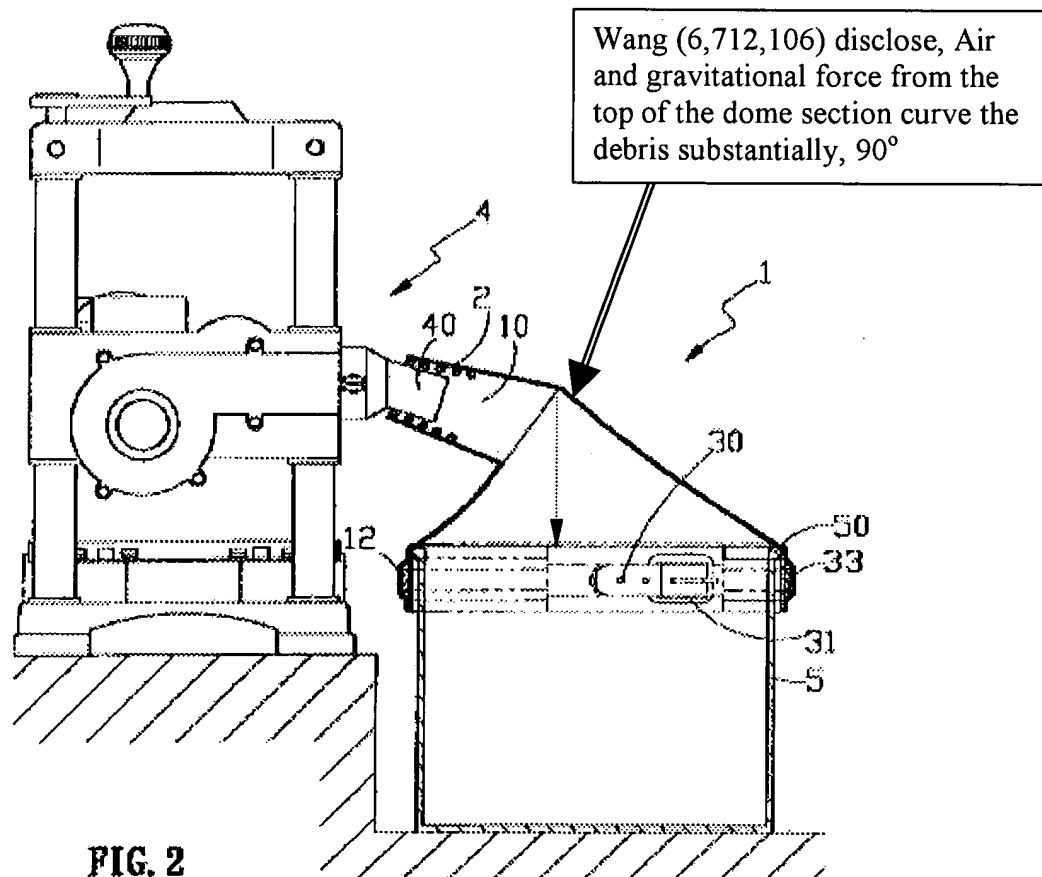
With regard to claim 11 as best as can be understood, Wang disclose the cap releasably attached to the receptacle (fig. 1,2, 4).

With regard to claim 13 as best as can be understood, Wang discloses the connector integrally formed with the cap (fig. 4).

As to the transparent window (clm. 14), Examiner notes that Schneider teaches the use of various materials for the connector (col. 3, lines 11-27), one such material being any synthetic or man-made flexible material. Examiner notes, many transparent materials to be synthetic materials, such as polypropylene. Because Applicant has not stated a specific type of transparent material, Examiner notes Schneider to teach construction using transparent material.

With regard to claim 15 and 16 as best as can be understood, Wang discloses a part spherical shaped section (10; fig. 2) that cures the path of the debris as it passes through the part spherical section.

As to the 90 degrees (clm. 16) Examiner notes that the spherical section (10) curves the path of the debris and that some of the debris will follow the spherical section (10) to a highest most point and fall by air and gravity force downward, i.e., at a 90 degrees (fig. 2).



Claim 17 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Liao et al. (6,481,475) and Schneider (6,520,365). As noted above with reference to claim 1, Wang discloses, a planer having a planer body (fig. 2), receptacle (5), cap (fig. 4) and conduit for removal of debris. Wang does not disclose a cutting drum rotatably mounted in the planer body, however it is obvious that the

planer apparatus has a means for cutting so as to planarizer a work piece. Liao teaches in a similar art, a planer (fig. 2) having a planer body, debris exhaust conduit (43) and rotatable cutting member (35) mounted within the planer body.

Schneider teaches as noted above a receptacle having a first and second rigid section and deformable section there between.

Because both Wang and Liao are from a similar art and deal with a similar problem (i.e., collecting/storing debris from a planer apparatus/device) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Wang's means for cutting with a rotatable cutting member as taught by Liao so as to efficiently planarizer a work surface.

Further, it would have been obvious for the reasons set forth with regard to claim 1 to replace, Wang's receptacle with a collapsible receptacle (i.e., first and second rigid sections and deformable section there between) as taught by Schneider so as to efficiently store the receptacle when not in use.

Allowable Subject Matter

Claim 12 appears to contain allowable subject matter and is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the 35 U.S.C. 112 rejection(s) were overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest a debris collection container for a planer comprising a means for connecting comprising a first part including two pegs and a

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second part having a T-shaped slot, wherein one of the first part and the second part is mounted on the receptacle and the other of the first part and the second part is mounted on the cap in combination with the rest of the claimed limitations as set forth in claim 12.

The prior art reference, Wang discloses a connector (80) having rails, connection plates (81) and grooves (801) such that the plates (81) are positionable within the grooves (801) of the rails (80) so as to connect the cap (fig. 4) to the receptacle (5). Further, Wang discloses that the cap (fig. 4) is connected to the receptacle by the fastening member (31, 33, 300). Wang does not disclose or fairly suggest first and second parts having pegs and T-shaped slots wherein a one of the first and second parts is mounted on the receptacle and the other of the first and second parts is mounted on the cap. Instead, Wang discloses that the means for connecting the cap to the receptacle is mounted on the cap (fig. 4) with a flange (50) on the receptacle to correlate with the rails (80) and fastening means (33). Accordingly, Wang fails to anticipate or render obvious the claimed invention as set forth in claim 12.

Conclusion

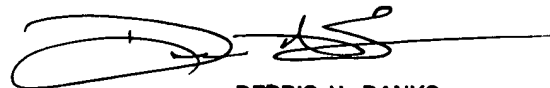
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

July 5, 2005



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